

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Charles Tresser, et al.

Examiner: John M. Winter

Serial No: 09/734,086

Group Art Unit: 3621

Filed: December 11, 2000

Docket: YOR920000598US1 (13893)

For: SECURE ELECTRONIC
STOCKS AND OTHER
TITLES AND INSTRUMENTS

Dated: March 31, 2008

Confirmation No.: 3901

Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST FOR RECONSIDERATION OF APPEAL BRIEF

Dear Sir:

This request for reconsideration is filed in response to the Notification of Non-Compliant Appeal Brief (37 C.F.R. 41.37) dated February 29, 2008, which issued in connection with the Brief on Appeal submitted February 19, 2008.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being deposited with the United States Patent & Trademark Office via Electronic Filing through the United States Patent and Trademark Office e-business website, on March 31, 2008.

Dated: March 31, 2008



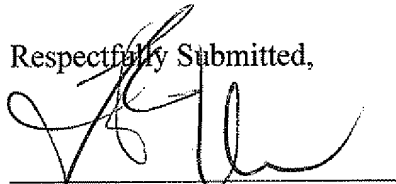
John F. Vodopia

REMARKS

The Notification on Non-Compliant Appeal Brief dated February 29, 2008 ("the Notification"), indicated a deficiency that the brief on Appeal allegedly did not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)), that the argument section did not match the grounds section in so much as each grounds corresponds to a heading within the argument (typo 102(a) should read 103(a)). The Notification further indicated that the entire Brief on Appeal is not required, only the section found defective.

In response, appellants submit amended VII. ARGUMENT, A. The combination of Leighton, Mital and Orrin does not render claims 1-11, 13, 15, 16 and 19-24, unpatentable under 35 USC §103(a), which corrects the typo: "102(a)" to correctly read "103(a)." A copy of the amended section VII is attached hereto.

This amended Section VII, submitted in response to the Notification, is now believed to be fully compliant with the patent rules, and appellants respectfully request reconsideration of the amended Brief on Appeal. If a telephone conference with applicant's attorney would support disposition of this application, and Petition, the Examiner is urged to telephone the undersigned at the number set forth below.

Respectfully Submitted,

John F. Vodopia
Registration No. 36, 299

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza-Suite 300
Garden City, NY 11530
(516) 742 4343
JFV: tb

VII. ARGUMENT

A.) The combination of Leighton, Mital and Orrin does not render claims 1-11, 13, 15, 16 and 19-24, unpatentable under 35 USC §103(a)

Appellants submit that the final rejection of claims 1-11, 13, 15, 16 and 19-24 under 35 USC §103(a) over Leighton in view of Mital and Orrin is improper in view of the fact that the combination does not disclose Appellants' invention as claimed.

In the final Office Action, the rejection of claims 1-11, 13, 15, 16 and 19-24 under 35 USC 103(a) over Leighton in view of Mital and further in view of Orrin was maintained (on final).

With respect to independent claims 1, 7 and 13, the Examiner states therein that Leighton substantially discloses the limitations of the current application such as: creating digitally secure documents using cryptography, concatenation of data strings, digital signature, etc., in the Abstract, and at column 1, line 1- col. 2, line 16. The Examiner asserts that Leighton discloses creating titles for personal and real property, including a digital signature of the owner at column 1, lines 35-68; the owner transferring ownership of the financial instrument to another person, the owner, using a public signature schema of the owner, signing the title using a public signature scheme of the owner and appending to the title a public part of a signature scheme of said other person (i.e., the third party transferee), at column 2, lines 51-68.

The Examiner acknowledges that Leighton does not explicitly disclose a second party transferee and appending a message to the title including a public part of a signature scheme, a third party emitter issuing to the owner a title for a financial instrument and a message describing the title and how to contact the emitter.

The Examiner then asserts that Mital discloses a third party emitter issuing to the owner a title for a financial instrument and a message describing the title and how to contact the emitter, at col. 2, lines 22-62, col. 22, line 24-col. 23, line 20, and col. 27, lines 17-53, to prepare a secure authenticated digital document with digital signature to be transmitted over the Internet, and that it would have been obvious to modify Leighton, and include a third-party emitter issuing

to the owner a title for a financial instrument and a message describing the title and how to contact the emitter, as disclosed by Mital, to prepare a authenticated digital document for sending over the Internet.

The Examiner further asserts that Leighton discloses transferring ownership to another person, but fails to explicitly disclose a second party transferee and appending a message to the title, said message including a public part of a signature scheme. The Examiner then asserts that Orrin discloses a second party transferee (assignee), and appending a message to the title that has a public part (pars. [004], [015], [030]), to electronically represent a legally binding document showing the current ownership (assignor), transfer of the ownership to the next owner (assignee), reducing reliance on paper documents and presenting the document in electronic format, and that it would therefore have been obvious to modify the disclosure of Leighton with Mital, and to include appending a message to the title that has a public part, as disclosed by Orrin.

Appellants respectfully disagree, and urge the Board of Patent Appeals to overturn the final rejection of independent claims 1, 7 and 13, and the claims that depend therefrom.

Initially, appellants respectfully assert that there is no reason stated in the outstanding final Office Action that would have prompted the skilled artisan at the time of the invention to make such a combination, a requirement for establishing a prima facie case of obviousness under the law of section 103(a). While the Examiner states that the combination of Leighton, Mital or Orrin has the ability to form a legally binding digital document and messages such as time-stamp with digital signature either in or out of presence of an official such as a notary, attorney, etc., to be transmitted electronically as a non-secure communication such as via the Internet, applicants respectfully assert that this reason is attributable to inventions directed to secure transactions. That is, each of the cited references appear to have for their intended purpose to realize legally binding documents.

In the recently decided US Supreme Court case KSR Int'l Co. v Teleflex, Inc., No. 04-1350 (US; April 30, 2007), it was held that an analysis supporting a rejection under 35 USC §103(a) should be made explicit “to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. Because there is no explicit analysis contained in the final Office Action for the proposed Section 103(a) combination of Leighton with Mital, or Leighton and Mital combined with Orrin, the stated section 103(a) combination is inherently improper under Section 103(a), and should be overturned by the Board. That is, the Examiner’s reason is insufficient for establishing a prima facie case of obviousness under the law under the holding in KSR. But *assuming arguendo* that there is a proper reason in the prior art for combining Leighton, Mital and Orrin under section 103(a), Leighton, Mital and Orrin combined still fail to include that a second party transferee appends a message to the title that describes the title, and how to contact the third-party emitter, and includes the digital signature of the emitter and a public part of the signature scheme.

Generally, applicants independent claims 1, 7 and 13, and the claims that depend from these independent claims patentably distinguish over the Leighton, Mital and Orrin because none of the cited references show or suggest the feature, in a method of digitally managing the transfer title to financial instruments between a third party emitter, a first party owner and a second party transferee, where the third party emitter issues to the owner a title for a financial instrument, the title including (i) a message describing the title and how to contact the emitter, and (ii) a digital signature of the emitter, the owner transferring ownership of the financial instrument to the second party transferee, including the owner, using a public signature scheme of the owner, signing the title by appending a message to the title, and that the message includes a public part of a signature scheme of the second party transferee.

Significantly, the Court of Appeals for the Federal Circuit emphasizes that a strict identity test must be met in order for a reference to anticipate a claim under 35 U.S.C. 102. For instance, in Apple Computer, Inc. v. Articulate Systems, Inc., 57 USPQ2d 1057, 1061 (Fed. Cir 2000), the Court explained that: “[a]nticipation under 35 U.S.C. 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention.” “Substantial

identity” or “equivalency” is not sufficient. RCA Corp. V. Applied Digital Data Sys., Inc., 221 USPQ 385 (Fed. Cir. 1984).

MPEP 2141.01 sets forth that prior art available under 35 USC §102 is available under 35 USC §103. Ex Parte Andersen, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981), asserts that 35 USC §103 includes all of the various bars to a patent as set forth in 35 USC §102. Appellants respectfully assert that neither the final Office Action nor the Advisory Action establish that the combined references include each limitation of the invention as set forth in independent claims 1, 7 and 13, and that the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

Leighton discloses a system for preventing counterfeiting or otherwise illegal use of documents, i.e., forms a legally binding digital document. In the Leighton system, a title is provided with an identifier uniquely associated with the personal or real property that is the subject of the title, and information directly or indirectly identifying the owner of the property. Applicants have examined Leighton’s Abstract, and Leighton at col. 1, line 1-col. 2, line 16, and do not find a method of digitally managing the transfer of financial instruments between a third-party emitter, a first party owner and a second party transferee.

While the Examiner asserts that Leighton at col. 1, lines 35-68, discloses that a third party emitter issues to the owner a title for a financial instrument, the title including (i) a message describing the title and how to contact the emitter, and (ii) a digital signature of the emitter, applicants do not agree. The cited text states that Leighton creates secure titles including an identifier uniquely associated with personal or real property to be identified, and information directly or indirectly identifying the legal owner of the title. The identifier, for example, is a vehicle identification number for title to a motor vehicle, and information either directly or indirectly identifying the legal owner is concatenated into a data string that is digitally signed using a secret key of a public cryptosystem pair.

To verify title, a transaction terminal uses a corresponding public key to decrypt the data string. Leighton at col. 1, lines 35-68, however, does not disclose a third party emitter

issuing to an owner a title for a financial instrument including (i) a message describing the title and how to contact the emitter, and (ii) a digital signature of the emitter.

While the Examiner further asserts that Leighton at col. 2, lines 51-68, discloses (A.) the owner transferring ownership of the financial instrument to another person, and (B.) the owner, using a public signature schema of the owner, signing the title using a public signature scheme of the owner and appending to the title a public part of a signature scheme of said other person (i.e., the third party transferee), applicants do not find the claimed elements at the cited portions of Leighton.

Applicants read the cited Leighton text as merely discussing digital signatures and public-key cryptosystems and how a digital signature can be used to bind information to a title. There is no teaching or suggestion of having an owner transfer ownership of a financial instrument to a second party transferee, including that the owner, using his or her public signature scheme, appending a message to the title, where this message includes a public part of a signature scheme of the transferee.

The Examiner further asserts that Mital discloses a third party emitter issuing to the owner a title for a financial instrument and a message describing the title and how to contact the emitter (col. 2, lines 22-62, col. 22, line 24-col. 23, line 20 and col. 27, lines 17-53) to prepare a secure authenticated digital document with digital signature to be transmitted over the Internet. The Examiner the concludes that it would have been obvious to modify Leighton and include a third-party emitter issuing to the owner a title for a financial instrument and a message describing the title and how to contact the third-party emitter to prepare a authenticated digital document for sending over the Internet.

Applicants respectfully disagree that Mital teaches a third party emitter issuing to the owner of title for a financial instrument and a message describing the title and how to contact the emitter at col. 2, lines 23-62, col. 24, line 24-col. 23, line 20, and col. 27, lines 17-53. At col. 2, Mital refers to a computer user named Carl who wishes to signs a digital document. Carl directs his computer to create a public/private key pair, encrypts the document with his private

key, and sends the signed document with the public key to Doug (Doug's computer). The cited text then sets forth the particular of a similar exchange between Eric and Frank. Nowhere does Mital disclose a third party emitter issuing to the owner of title for a financial instrument and a message describing the title and how to contact the emitter.

While the Examiner asserts that Orrin discloses a second party transferee (assignee), and appending a message to the title that has a public part (par. 004, 015, 030), and that it would therefore have been obvious to modify the Leighton as modified by Mital combination to include appending a message to title that has a public part, as disclosed by Orrin, applicants again respectfully disagree. The cited Orrin paragraphs merely recite having the owner, using his or her public signature scheme, append a message to the title, where this message includes a public part of a signature scheme of the transferee.

Applicants' independent claims include the limitation that the owner transferring ownership of the financial instrument to the second party transferee, the owner, using a public signature scheme of the owner, signing the title by appending a message to the title, said message including a public part of a signature scheme of said second party transferee.

Hence, combining Leighton with Mital and Orrin does not remedy the shortcomings of Leighton, or Leighton combined with Mital, with respect to the independent claim language. That is, combining Leighton, Mital and Orrin still would not realize a method such as that set forth in applicants' independent claims, including a third party emitter issuing to the owner a title to a financial instrument, the title including a message describing the title and how to contact the emitter, and a digital signature of the emitter, the owner transferring ownership of the financial instrument to the second party transferee, including the owner, using a public signature scheme of the owner, signing the title by appending a message to the title, said message including a public part of a signature scheme of said second party transferee, a limitation in each of claims 1, 7 and 13.

Due to the above-discussed differences between claims 1, 7 and 13 and the Leighton, et al., Mital and Orrin combination, and because of the advantages associated with

these differences, claims 1, 7 and 13 patentably distinguish over the prior art and are allowable. Claims 2-6 and 19-24, are dependent from claim 1 and are allowable therewith; claims 8-11 are dependent from claim 7 and allowable therewith; and claims 15, 16 depend from claim 13 and are allowable therewith.

The Board of Patent Appeals and Interferences, therefore, is respectfully asked to overturn the final rejection of claims 1-11, 13, 15, 16 and 19-24 under 35 U.S.C. §103 (a) by the Leighton, Mital and Orrin combination, and to allow the claims.

The other references of record have been reviewed, and these other references, whether considered individually or in combination, also do not disclose or suggest this feature of the present invention.

**TRANSMITTAL LETTER
(General - Patent Pending)**

Docket No.
YOR920000598US1 (13893)

In Re Application Of: **Charles Tresser, et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/734,086	December 11, 2000	John M. Winter	23389	3621	3901

Title: **SECURE ELECTRONIC STOCKS AND OTHER TITLES AND INSTRUMENTS**

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Request for Reconsideration of Appeal Brief

in the above identified application.

- ☒ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **50-0510/IBM** as described below.
- ☒ Charge the amount of _____
- ☒ Credit any overpayment.
- ☐ Charge any additional fee required.
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.



Signature

Dated: **March 31, 2008**

John F. Vodopia
Registration No.: 36,299

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza-Suite 300
Garden City, NY 11530
(516) 742-4343

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____	
(Date)	
_____ <i>Signature of Person Mailing Correspondence</i>	
_____ <i>Typed or Printed Name of Person Mailing Correspondence</i>	

JFV:tb

cc: